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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	88458681
Applicant	OptConnect Management, LLC
Applied for Mark	OPTCONNECT MANAGED WIRELESS SOLUTIONS
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Submission	Applicants Request for Remand and Amendment
Attachments	OPTCONNECT MANAGED WIRELESS SOLUTIONS SN 88458681 Request to Amend Application and Remand.pdf(97675 bytes)
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Date	01/14/2021

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re Application of OptConnect Management, LLC

Ex Parte Appeal No. 88/458,681

Trademark: OPTCONNECT MANAGED WIRELESS SOLUTIONS & Design

APPLICANT’S REQUEST TO REMAND APPLICATION

Pursuant to TBMP §§ 1205.01 and 1209.04, Applicant OptConnect Management, LLC (“Applicant”) hereby respectfully requests that the Trademark Trial and Appeal Board (the “Board”) suspend proceedings in this *ex parte* appeal and remand the application to the examining attorney for consideration of Applicant’s proposed amendment of the identification of goods and services in its application, which Applicant believes will obviate the examining attorney’s Section 2(d) refusal of this application.

I. Background

Applicant has applied to register the mark OPTCONNECT MANAGED WIRELESS SOLUTIONS & Design on the Principal Register in Classes 9, 38, and 42 (the “Application”).

In his September 4, 2019 initial office action, the examining attorney refused registration of the Application on the grounds of alleged likelihood of confusion with cited Reg. No. 3,914,101, and also required Applicant to clarify the identification of goods and services, agree to disclaim exclusive rights to MANAGED WIRELESS SOLUTIONS, and submit a new mark drawing. On March 4, 2020, Applicant made the requested changes to the identification of

goods and services, agreed to the disclaimer of MANAGED WIRELESS SOLUTIONS, and submitted arguments as to why confusion with the cited registration is not likely.

On April 2, 2020, the examining attorney issued a final office action, requesting a new mark drawing and maintaining the Section 2(d) refusal of Applicant's mark. On October 2, 2020, Applicant filed a Request for Reconsideration with a new mark drawing and new arguments and evidence supporting why confusion with the cited mark is unlikely. The Request for Reconsideration proposed the addition of language to the Class 9 identification limiting the use of Applicant's "computer hardware for running firmware or software for use in machine-to-machine (M2M) and internet of things (IoT) applications, communications, and interfaces" to "automated teller machines, commercial laundries, vending machines and self-service retail, retail store point-of-sale, and agriculture" (the "Class 9 Amendment"), thereby reinforcing the different functionality, trade channels, and purchasers of Applicant's and the cited registrant's respective goods, and also requested an interview with the examining attorney. Applicant also filed an accompanying Notice of Appeal.

On November 11, 2020, the examining attorney and Applicant's counsel had a telephone interview. In that interview, the examining attorney advised that he planned to deny the Request for Reconsideration but noted that the addition to all Classes of limiting language like that already added to Class 9 might be sufficient to resolve the Section 2(d) refusal. On November 12, 2020, the day after the interview, the examining attorney issued a denial of Applicant's Request for Reconsideration.

Based on the November 11 interview with the examining attorney, Applicant hereby seeks remand to add limiting language to all three Classes in the Application, which Applicant believes will obviate any likelihood of confusion with the cited registration. Specifically,

Applicant seeks to add the following clause to the end of the identification in each of Classes 9, 38, and 42:

“; all of the foregoing for use in connection with automated teller machines, commercial laundries, vending machines and self-service retail, retail store point-of-sale, agriculture, and cash automation systems.”

Because Applicant seeks to add the above language to the end of each Class, including Class 9, Applicant will also request deletion of the October 2020 Class 9 Amendment since that amendment is made redundant by the new limiting language.

II. The Application Should Be Remanded to Allow Applicant to Obviate a Ground for Refusal

The *Trademark Trial and Appeal Board Manual of Procedure* provides that the Board will grant a request to remand to consider an amendment upon a showing of good cause. TBMP §§ 1209.04; 1205.01. “Good cause will generally be found, for example . . . when the amendment will obviate a ground for refusal.” TBMP § 1205.01.

Here, Applicant requests remand of this matter to amend the Application in a way that Applicant believes will further distinguish Applicant’s mark from the cited mark and thus resolve the Section 2(d) refusal. As Applicant’s proposed amended identification makes clear, Applicant uses OPTCONNECT MANAGED WIRELESS SOLUTIONS & Design on highly specialized machine-to-machine device networking products and related services. The products are purchased to become components of, or work with, other devices, and to enable those devices to engage in sophisticated machine-to-machine communication. Applicant’s products become the communication “brains” of a variety of devices including, for example, automated teller machines, commercial laundries, vending machines and self-service retail. By contrast, the cited mark OPCONNECT is registered for “Interactive computer kiosks comprising computers, computer hardware, computer peripherals, and computer operating software, for use in digital

advertising and electric vehicle charging” – in other words, a finished product (i.e. an “interactive kiosk”) ready to be placed in a parking lot to charge electric cars.

The goods sold by Applicant and by the cited registrant therefore have vastly different functionality. Applicant’s proposed limitation of the identification of goods and services in Classes 9, 38, and 42 aims to highlight these differences and reinforce that there is simply no potential for consumer confusion between Applicant’s machine-to-machine device networking products and services and the cited registrant’s finished kiosks.

Good cause exists for the remand. This appeal is in its very beginning phase, and granting a remand will not interrupt a briefing schedule or otherwise disrupt the appeal process. Applicant notes that the interview between Applicant’s counsel and the examining attorney, in which the examining attorney advised that the addition of limiting language to all three Classes in the Application might obviate the 2(d) refusal, occurred the day before the examining attorney issued his denial of Applicant’s Request for Reconsideration. Accordingly, Applicant did not have an opportunity to decide on the contemplated amendment language before the matter went to the Board on appeal. Moreover, Applicant believes that a remand should allow the examining attorney to resolve the only issue in dispute on the present appeal, obviating the need for the continued appeal proceeding.

III. Conclusion

For the reasons stated above, Applicant respectfully requests that this appeal be suspended and its Application remanded to the examining attorney to allow the examining attorney the opportunity to consider Applicant’s proposed amendment of the identification of goods and services, which Applicant believes will obviate the examining attorney’s Section 2(d) refusal of the Application.

Dated: January 14, 2021

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